UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,968	01/17/2002	Reinhold Holtkamp SR.	030502/0147	5426

22428 7590 05/08/2008

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
HAAS, WENDY C	

ART UNIT	PAPER NUMBER
1661	

MAIL DATE	DELIVERY MODE
05/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REINHOLD HOLTKAMP SR.

Appeal 2007-4136
Application 10/046,968
Technology Center 1600

Oral Hearing Held: April 8, 2008

Before DONALD E. ADAMS, RICHARD M. LEBOVITZ, and FRANCISCO C. PRATS, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANT:

RICHARD PEET, ESQ.
Foley & Lardner, LLP
3000 K Street, N.W., Suite 500
Washington, DC 20007

The above-entitled matter came on for hearing on Tuesday, April 8, 2008, commencing at 9:00 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, 9th Floor, Hearing Room B, Alexandria, Virginia, before Kevin E. Carr.

JUDGE ADAMS: Good morning.

THE USHER: Calendar number 6, appeal number 2007-4136, Mr. Peet.

JUDGE ADAMS: Thank you.

Good morning, Mr. Pete

MR. PEET: Good morning.

JUDGE ADAMS: While you're getting ready, we are going to let you know that we've read your brief and are familiar with the case. And you have 20 minutes, and if you would spell your name into the record, we'd appreciate it, and you can begin when you're ready.

MR. PEET: Richard Peet, P-e-e-t. Thank you very much. I'm very happy to have the opportunity to speak to you today about our appeal.

The claims in this invention are directed to African violet plants that have at least one leaf axil with more than one flower stem. These plants as I'm sure you've seen from the specification and figures and the photographs that are there have multiple flowers, and they have been very popular in the marketplace. They were obtained in a very interesting way, as I am sure you have seen from the specification the seeds that gave rise to this mutation spent six years in space. And from the 25,000 seed that were incubated in space for that time period, a number of very interesting mutations were obtained, one of which is this multiflorescence characteristic which was described in the application.

The examiner has not cited any prior art that's on appeal here. We're dealing with enablement and written description rejections, and I'd like to if I could address the enablement rejection first. As you've seen, there was a deposit made of seed carrying the multiflorescence trait. And the examiner has taken the position that we haven't taught each and every way of making plants having this particular characteristic. And I think that's a mischaracterization of the law.

The specification, I think, contains a large amount of evidence and data showing that this particular trait can be introgressed or bred by traditional breeding methods well known to anyone with skill in the art in diverse genetic backgrounds, and this is the key to enablement in this case. In particular, I wanted to direct your attention to page 18 of the specification where the applicant has noted that in crosses of plants carrying

multiflorescence trait with plants that don't carry the trait, 50% of the progeny of that cross, exhibit the multiflorescent characteristic. And in crosses of plants, each containing multiflorescence trait, or exhibiting the multiflorescence trait, I should say, roughly 80% of the plants, progeny from those crosses, exhibit the trait.

JUDGE LEBOVITZ: Can I ask a question?

MR. PEET: Certainly.

JUDGE LEBOVITZ: What I saw in the spec, or in one of the claims, was that you get two to three stems. But the claims are broader than that. Is there any evidence that you can actually get more than three?

MR. PEET: You know, this was not an issue that was raised during examination; the number of stems, the examiner never raised that issue. The inventor has obtained plants with higher numbers of stems, and in fact with some varieties, as we note in the specification, the number of stems actually can increase as the plant matures. So that's an interesting characteristic of some of the plants that they've obtained from these crosses.

JUDGE LEBOVITZ: That's in the spec?

MR. PEET: Yes.

JUDGE LEBOVITZ: Can you direct me where?

MR. PEET: It's on 18, perhaps; yes, page 18, lines 13 through 14.

JUDGE LEBOVITZ: Okay, thank you. So the older the plant, the more likely, have plants that have three or more flowers?

MR. PEET: In some varieties; I mean, that's been a characteristic that is variety dependent. And, I should note, that in the crosses as evidenced in the specification, when the trait is introgressed into these varieties and we give a number of commercial varieties that have been obtained by this method in the specification, importantly, the multiflorescence trait is stable through asexual propagation.

So what we have here is a method of introgressing the trait into diverse genetic backgrounds. It's not dependent upon the seed that's been deposited. Any plant from these crosses that exhibits the multiflorescence trait has been shown to be able to be a source of the gene or genes required for introgressing the trait, reproducibly and predictably into different genetic backgrounds. When you talk about the fact in the specification that the trait

can be recombined with different flower colors, different plant forms, a variety of different traits. So it's not for example linked to any particular characteristics. It can be introgressed into different genetic backgrounds; and, therefore, fully enabling in our view the scope of the claims.

JUDGE LEBOVITZ: So traditional breeding techniques, they are able to produce these African violets that have this multiflorescent trait that's not stable?

MR. PEET: Yes.

JUDGE LEBOVITZ: You can't pass it along down through generation after generation. Is that what you mean by stable?

MR. PEET: Yes, exactly. So in other words, once the trade is, let's say that you have as some of the examples, they've recombined the multiflorescence trait into a background with a different flower color and you can predictably make those crosses and recombine the multiflorescence trait with other characteristics that might be meaningful in the marketplace, such as flower color, plant form, and so forth.

JUDGE LEBOVITZ: Right. The traditional breading technique can give rise to an African violate that has this multiflorescent trait. Correct?

MR. PEET: That's right. Once you have a source of a plant.

JUDGE LEBOVITZ: Okay. So how does the traditional breeding technique or the plant that's obtained by the traditional breeding technique differ from the plant in claim 1?

MR. PEET: The plant in claim 1 prior to the inventor's selection.

JUDGE LEBOVITZ: Well, take a look at how you've written claim 1. Now, you admitted to me just a few seconds ago that traditional breeding techniques can give rise to African violet cultivars that have more than one flower stem.

JUDGE LEBOVITZ: If you have a source of this unique mutation that wasn't previously known. Well, that's inconsistent with what you see at page 3 of the spec, right? Page 3 of the spec says "traditional rating techniques have failed to produce a stable African violet cultivar with more than one flower stem." Stable just means it's capable of passing it on to its progeny.

MR. PEET: Yeah. All that is meant there is that in the prior art there hasn't been any plants as far as we know and as far as the examiner determines, any plants exhibiting the multiflorescence characteristic. Once this particular mutation was obtained then they have found through--

JUDGE LEBOVITZ: That you can stably pass it on, right?

MR. PEET: Yeah, all that is meant there in the prior art there hasn't been any plants as far as we know, and as far as the examiner has determined, any plants exhibiting the multiflorescence characteristic. Once this particular mutation was obtained, then they have found.

JUDGE LEBOVITZ: That you can stably pass it on, right?

MR. PEET: That's right.

JUDGE LEBOVITZ: But there's nothing in claim 1 that's stable African violet claims comprising a stable multi-florescent trait.

MR. PEET: And we would argue that that's an inherent characteristic of once you have obtained this mutation that now it's possible to make as evidenced by the data in this application make plants that stably exhibit the multiflorescence trait.

JUDGE LEBOVITZ: That's not what you claim. See, I'm having trouble here with the statement at page 3 of your specification. It's the paragraph starting at line 2, thus far. So, take a moment and read essentially the first sentence.

MR. PEET: Yeah, and all that's being stated there is that as far as we know, the prior art did not teach the multiflorescence trait.

JUDGE LEBOVITZ: They didn't teach a stable multiflorescent trait.

MR. PEET: Yeah, or stable.

JUDGE LEBOVITZ: Well, it doesn't say "or stable." It just says they failed to produce a stable cultivar. Your first claim doesn't require a stable cultivar.

MR. PEET: Yeah, and in my view, it's not required, because the patentable invention here is the multiflorescence trait.

JUDGE LEBOVITZ: So if traditional breeding techniques can give rise to a multiflorescent trait, albeit that it's not stable, it reads on your claim. Right?

MR. PEET: No. And there's no prior art that the examiner, or we were not aware of any prior art that even teaches an unstable multiflorescence trait. The examiner has found that, I could see him or her using that in a prior art rejection that was never found. We are not aware of that either.

JUDGE LEBOVITZ: Yeah, but the sentence I directed you to is kind of strange, just because of the way it reads. It sort of infers that yea, we've seen these traits before, but they're just not stable. We can't pass them on.

MR. PEET: All we meant to confer there was the prior art does not teach as far as we know either stable or unstable multiflorescence. And the examiner never cited any prior art. We're not aware of, as I stand here today, any prior art that teaches this multiflorescence trait.

In terms of enablement, which was the issue the examiner was concerned about, I think the data is overwhelming in the application that you can introgress this trait into diverse backgrounds, whether it be the deposited seed or a plant exhibiting the multiflorescence trait to fully enable the scope of the claims.

JUDGE LEBOVITZ: Well, in terms of the enablement, what was the thrust of the examiner's argument, simply?

MR. PEET: Yeah. I think the main concern that I think the examiner had is that we didn't teach a number of different ways of making this multiflorescence trait; for example, that we didn't explain the genetic basis of it, whether it was a single gene, multiple genes. And, of course, we have no obligation to provide the theoretical underpinning. All we need to do is show that you can reproducibly, predictably, make the claimed plants using the methods that we have described in the application; and, I believe that's what the data in the application shows.

JUDGE LEBOVITZ: And, your position on the legal view is that under enablement law, you only need one way.

MR. PEET: That's correct, under Hogan and other cases.

JUDGE LEBOVITZ: One mode of making it.

MR. PEET: Under Hogan and other cases that we cite in the application that that's longstanding law.

JUDGE ADAMS: And, could you clarify? It seems to me in the enablement issue the examiner comes out and says, "This is a dominant trait." On the other hand, we have the written description issue and the examiner questions whether this trait is dominant or not dominant.

Would you clarify that inconsistent position for us?

MR. PEET: Yeah, I mean, I'm not certain that that's the basis of the examiner's concern about written description. I think the examiner in my view seems to mix up written description and enablement, because we have a very clear statement in the specification that at the time the invention was made, you know, we had possession of plants exhibiting the multiflorescence trait. That is, you know, at least one leaf axil with at least two or more flower stems.

With regard to enablement, it appears that the data would indicate that it's a dominant trait and it appears to segregate as a single gene. But, you know, we don't know that. As I stand here today, I don't know that for certain. That's my supposition based upon the data that's there; and, that would certainly support strong evidence of enablement in my view, because the data clearly shows if you have a plant with that multifluorescence trait, you can reproduce it predictably, select for progeny, and recombine it with other characteristics to produce plants that have the claimed characteristics in the full scope of the claim.

JUDGE ADAMS: We don't know anything about the genetics of this particular trait. We don't know how it's inherited, other than, and I think you just said it was dominant. Right?

MR. PEET: Well, you know, we don't state that in the application. But, if you look at page 18, the data that is provided indicates that in a cross between a plant that doesn't exhibit the multiflorescence trait with one that does, about fifty percent of the progeny will exhibit, the plants that are produced from that will exhibit, a multiflorescence trait.

JUDGE LEBOVITZ: That would be the case if it were heterozygous.

MR. PEET: That's right. That's right. But, you know, it could be much more complex than that.

JUDGE ADAMS: But no one knows that, right? No one knows anything about it.

MR. PEET: Right, and as we point out in our brief, we're not required under the law to provide that theoretical basis. What is required, of course, is to provide a reproducible, predictable way, without undue experimentation, of making the claimed invention. I believe the data speaks for itself in the application that the applicant has done that.

JUDGE ADAMS: All right. You have a few minutes remaining. Is there anything else you wanted to say?

MR. PEET: Those were the critical points that I wanted to make and I really appreciate you taking the time.

JUDGE ADAMS: Does anyone else have any questions?

We don't have any outstanding questions.

MR. PEET: Great. Thank you very much for taking the time to listen to my arguments.

(Whereupon, at 9:20 a.m., the proceedings were concluded.)